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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,708	12/02/2003	Yumiko Suzuki	8028-1046	2217
466 7590 11/26/2007 YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			EXAMINER WONG, XAVIER S	
			ART UNIT 2616	PAPER NUMBER
			MAIL DATE 11/26/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/724,708

Applicant(s)

SUZUKI ET AL.

Examiner

Xavier Szewai Wong

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11<sup>th</sup> September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ✓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

- 5) ☐ Notice of Informal Patent Application

- 6) ☒ Other: JPO. Machine Translation for WO 01/78317 ✓

### DETAILED ACTION

- Applicant's Amendment filed 11<sup>th</sup> September 2007 is acknowledged
- Claims 1, 2, 4, 5, 7 and 9 have been amended
- Claims 3, 6, 8 and 10 have been cancelled
- Claims 1, 2, 4, 5, 7 and 9 are still pending in the present application
- This action is made NON FINAL

### *Response to Arguments and Remarks*

1. A Japanese Patent Office machine-translated English copy of prior art **Nakai et al (WO 01/78317 A1)**, based on Japanese Patent **JP 3,327,918 B**, is provided for reference. A certified English translation copy of **Nakai et al** is ordered on 16<sup>th</sup> November 2007 and will be forwarded to the applicant's attorney once available. This action is made NON FINAL.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 4, 5, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Nakai et al (WO 01/78317 A1)**.

Consider claims 1, 5, 7 and 9, **Nakai et al** disclose a network segment 200/201 (*interpreted* as Key Telephone System "KTS" Main Unit) comprising means for: accommodating IP extension terminal units – an internal contents server 202 and an intranet 400 with another contents server 401 – that are able to route/switch (call or message) data with key telephone system terminal units – portable terminal 101 and computer 102 – in which both KTS terminal units are outside the LAN and being able to access the KTS main unit 200/201 and the IP extension terminal units (pg. 6 lines 26-29, pg. 7 lines 1-20; *abstract*; fig. 1). The network segment 200/201 comprises an authentication function 200a with login means that requires outside KTS user units (e.g.

101, 102) to input a predetermined ID 203d and password 203c to obtain access into the segment's IP addresses 206a (pg. 7 lines 21-25, pg. 8 lines 8-25; fig. 2). The outside KTS units receive terminal ID 203e (in process of being registered and authenticated) and user information is being stored in database 203 (pg. 8 lines 26-29, pg. 9 lines 1-15; fig. 6). Communication between the (KTS) terminal units and the IP extension terminal units can be accomplished by VoIP technology (pg. 1 lines 12-21, pg. 23 lines 15-19). **Nakai et al** further disclose database 203 contains information including an "internal" telephone directory so the IP extension terminal units (e.g. 202, 400, 401) can know whether each extension terminal units can communicate with one another or not (pg. 7 lines 21-25; fig. 8 item 7). As outside (KTS) user units (e.g. 101, 102) input a predetermined ID 203d and password 203c to obtain access into the segment's IP addresses 206a (pg. 7 lines 21-25, pg. 8 lines 8-25; fig. 2), the outside (KTS) units receive terminal ID 203e (in process of being registered and authenticated inherently when the IP extension unit is ON) and user information (ID, password, etc.) is being stored in database 203 (pg. 8 lines 26-29, pg. 9 lines 1-15; fig. 6). Through the outside (KTS) user terminal (display/portal), a user logs-on as a menu 500 that leads to internal information as a URL webpage (pg. 11 lines 11-29, pg. 12 lines 1-9; figs. 6-9). While **Nakai et al** *may not have explicitly* mentioned that the system is a Key Telephone system (KTS), the features of having multiple phones 101 (or computer 102) connecting to a private network segment 200/201 of a *central office* may be interpreted as a KTS for similar performance of internal accesses.

Consider claim 4, and as applied to claim 1 above, **Nakai et al** disclose the network segment 200/201 comprises a telephone directory (fig. 8 item 7); a routing functionality 200c for sending, receiving and storing e-mails in cache (pg. 20 lines 14-19, pg. 21 lines 4-10, pg. 22 lines 14-20; fig. 5); and though **Nakai et al** did not explicitly mention the storing of voice message (**Nakai et al** instead mention the Voice Over Internet Protocol VoIP capability on pg. 1 lines 16-21 and pg. 23 lines 15-19), it would have been obvious to a person who has ordinary skill in the art at the time the invention was made to incorporate the teachings of a voice mail/storage system in order to give users another option to receive or record messages on top the traditional text e-mails.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Nakai et al (WO 01/78317 A1)** in view of **Tsukamoto (US 2007/0201653 A1)**.

Consider claim 2, as applied to claim 1, **Nakai et al** disclose in figure 2 a database 203 that stores a telephone directory list 203f and through communicating with database 204 and 206 to determine whether the connection is possible through TCP port and IP address identifications between the phones 101/102 and the external content server 400/401 (pg. 8 lines 19-25). **Nakai et al** further disclose as outside (KTS) user units (e.g. 101, 102) input a predetermined ID 203d and password 203c to obtain access into the segment's IP addresses 206a (pg. 7 lines 21-25, pg. 8 lines 8-25; fig. 2), the outside (KTS) units receive terminal ID 203e (in process of being registered and authenticated inherently when the IP extension unit is ON) and user information (ID, password, etc.) is being stored in database 203 (pg. 8 lines 26-29, pg. 9 lines 1-15; fig.

6). However, **Nakai et al** *may not have explicitly* mentioned indicating the presence of each extension terminal units. **Tsukamoto** teaches the concept of a flag indicating the presence or non-presence of the destination phone number (paragraphs 0050-51). It would have been obvious to apply the concept of indicating a telephone number presence as taught by **Tsukamoto** to indicating the presence of external units in the invention of **Nakai et al** for identifying registered users.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Xavier Szewai Wong whose telephone number is 571-270-1780. The examiner can normally be reached on Monday through Friday 8:30 am - 6:00 pm (EST).

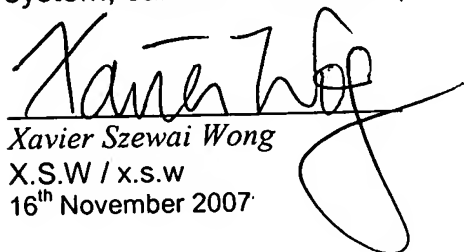
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

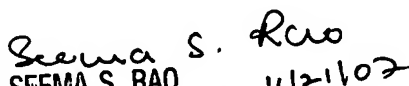
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information  
system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Xavier Szewai Wong  
X.S.W / x.s.w  
16<sup>th</sup> November 2007

  
SEEMA S. RAO  
11/21/07  
SUPERVISORY PATENT EXAMINER  
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